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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,783	08/15/2003	Lynn W. D'Amico	F-388-01	1782
919 7590 07/08/2008 PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000				
EXAMINER				
ERB, NATHAN				
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
07/08/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/604,783

**Applicant(s)**

D'AMICO ET AL.

**Examiner**

NATHAN ERB

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Quotations of statutes missing from this Office action with respect to rejections in this Office action may be found in a previous Office action.
2. Applicants' response to previous Office action was received on April 10, 2008.
3. In response to Applicants' amendment of the claims, all of the claim objections from the previous Office action are hereby withdrawn.
4. Applicants argue against Examiner's rejection of claim 1 under 35 U.S.C. 112, second paragraph, such rejection based on the claims containing actions to be performed if particular conditions are present, but not also stating what actions occur if such particular conditions are not present. Applicants argue that their claim language is definite and clear. Examiner disagrees. Claims 1, as amended, recites:

“1. A method for collecting usage data for a meter comprising:

determining whether data collection segregation rules are current; and

processing an update of the data collection segregation rules if the data collection

segregation rules are not current, wherein

the meter includes a removable UIC and a vault; and

further comprising:

determining whether the UIC and vault must be matched; and

determining whether the UIC is installed with the matching vault.”

The language of claim 1 that led to the rejection under 35 U.S.C. 112, second paragraph, is the conditional statement of: “if the data collection segregation rules are not current.” The problem with the claim is that the claim establishes what happens if data collection segregation rules are

not current ("processing an update of the data collection segregation rules"), but does not also specify what happens if the data collection segregation rules are current. In light of the U.S. Patent and Trademark Office's policy of giving claims their broadest reasonable interpretation, Applicants might argue that the claim language includes ANY action or inaction when the data collection segregation rules are current. However, such an interpretation creates problems. For example, if any possible action or inaction may result when the data collection segregation rules are current, such possible action or inaction might include "processing an update of the data collection segregation rules." In other words, the same action may result in both situations, when the data collection segregation rules are not current and when the data collection segregation rules are current. If the method operates the same whether or not the conditional statement "if the data collection segregation rules are not current" is true, it is then unclear (that is, indefinite) what, if any, limiting effect that conditional statement has on claim 1.

Furthermore, in general usage of the English language, an "if" conditional statement often implies that the action or inaction conditional on the "if" statement only occurs if that "if" statement is true. For example, consider the statement: "If you meet all the degree requirements, you will get your college degree." Such a statement would typically be interpreted to mean that an individual MUST meet all the degree requirements in order to get his or her college degree, and that if one does NOT meet all the degree requirements, he or she will NOT get his or her college degree. However, it is possible that degree requirements could be ignored as a formality and all students could be given their college degrees, whether or not they each met all the degree requirements. In such a case, the statement "If you meet all the degree requirements, you will get your college degree" would still be accurate, but such a situation would not at all be what many English speakers would regard as being implied by the statement "If you meet all the

degree requirements, you will get your college degree.” Likewise, it is unclear, that is, indefinite, whether or not claim 1, in its current form, **REQUIRES** that the data collection segregation rules not be current in order to further perform the step of “processing an update of the data collection segregation rules.”

The situation in claim 1 is further complicated by the fact that, if interpreted broadly, there may be NO resulting action required to happen if the data collection segregation rules are current. In such a case, in order to infringe claim 1, it may be sufficient simply to meet all the non-conditional elements/limitations of claim 1. Claim 1 could thus be infringed even if “processing an update of the data collection segregation rules” is not performed. Effectively, the “if” statement of claim 1 would “drop out” and be ignored. Yet it is counter to common sense that an applicant would include such substantive language in a claim and intend for the language to be ignored. Therefore, it is not only unclear whether the “if” statement of claim 1 is a mandatory requirement for the following actions to occur, it is also unclear how much of the language of claim 1 must be performed for claim 1 to be infringed. Therefore, the scope of claim 1 is not clear, and claim 1 is indefinite.

5. In light of the amendments of the claims, the rejections of the claims under 35 U.S.C. 112, second paragraph, have been correspondingly amended below in this Office action.

6. In light of the amendments of the claims, all of the prior art rejections of the claims from the previous Office action are hereby withdrawn.

#### ***Claim Rejections - 35 USC § 112***

7. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **Claim 1**, the claim contains an action that is to be performed if a particular condition is present. However, the claim does not also state what action occurs if that particular condition is not present. This renders the claim to be indefinite. The conditional statement being referred to here is: "if the data collection segregation rules are not current."

As per **Claims 2-7**, these claims depend, either directly or indirectly, from indefinite claim 1. None of these claims remedy the indefinite problems of claim 1. Therefore, these claims are also indefinite.

As per **Claim 8**, the claim contains an action that is to be performed if a particular condition is present. However, the claim does not also state what action occurs if that particular condition is not present. This renders the claim to be indefinite. The conditional statement being referred to here is: "if the data collection segregation rules are not current."

As per **Claims 9-19**, these claims depend, either directly or indirectly, from indefinite claim 8. None of these claims remedy the indefinite problems of claim 8. Therefore, these claims are also indefinite.

As per **Claim 20**, the claim contains an action that is to be performed if a particular condition is present. However, the claim does not also state what action occurs if that particular condition is not present. This renders the claim to be indefinite. The conditional statement being referred to here is: "if the data collection segregation rules are not current."

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Erb whose telephone number is (571) 272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Nhe

/JOHN W HAYES/  
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